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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,673	02/07/2002	Viktor Kaptelinin		7150

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EXAMINER

HUYNH, BA

ART UNIT	PAPER NUMBER
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2179

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04/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/067,673	Applicant(s) KAPTELININ, VIKTOR	
	Examiner Ba Huynh	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5,6,14-18,20,24,26 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5,6,14-18,20,24,26 and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/09 has been entered.

Claim Rejections - 35 USC § 103

Claims 3, 5, 6, 14-18, 20, 24, 26, 28 rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 6,803,930 (Simonson).

- As for claims 3, 20: Simonson teaches a computer implemented method and corresponding apparatus for displaying information in a window on a display device, the window displays only part of its related information, comprising the steps/means for:
 - providing a window for displaying a portion of a document (fig 8, 10-14),
 - providing scrollbar for scrolling the window,
 - displaying in the window a first portion (called portion A) of the document,
 - scrolling the window to a second portion (called portion B) of the document (the first portion A become a “previously viewed portion”, and the second portion B become “the newly presented portion” after scrolling. See 2:23-33, 9:33-35,

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causing a visual clues (1001, 1010, 1020, 1030, 1102, 1112, 1201, 1202, 1304), visually distinguishing new information from old information that overlaps from the first portion A, to be displayed in the window after scrolling from the first portion A to the second portion B so that the distinguishing visual clues do not obstruct the view of the new information (see description of figures 10-14), and disable the visual clues after a first predetermined amount of time (9:27-32; 10:1-7). Simonson further teach *an improvement* by not to display the visual clues unless the newly presented portion B is displayed for more than a predetermined amount of time (“the display state must remain unchanged for a certain length of time before any content differentiating indications would be displayed”. Simonson’s 11:28-30). The improvement help to avoid persistent background tinting of the previously display content which causes user distraction when scrolling quickly through the content (11:22-37). I.e., Simonson does not prefer to see the visual cue displayed if portion B is not the intended portion of the document the user wants to scroll to. Thus in Simonson, the visual cue will not be displayed in un-intended pages in disjoint scrolling, and displayed only at the page the user stop to read. Hence, Simonson time threshold is implemented at the intended page the user stop to read, instead of the previously viewed page as claimed, i.e., Simonson does not teach displaying of the visual clue if it is determined that the previously displayed portion had been displayed for more than a predetermined amount of time. Note: It is un-preferable to Simonson to display the visual cue in the next page in disjoint scrolling. However, it would have been obvious to one of skill in the art, at the time the invention was made, to implement the time delay at the previous viewed portion of the document instead of at the destination portion as in Simonson. Motivation of the implementation is for avoiding further time delay at the destination portion as in Simonson, with

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the tradeoff of having the visual cue un-necessarily displayed in disjoint scrolling and not displayed at all when the scrolling destination page is reached.

It has been held that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) (“Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a **conclusion of obviousness from common knowledge and common sense of the person of ordinary skill in the art** without any specific hint or suggestion in a particular reference.”); see also *In re Hoeschele*, 406 F.2d 1403, 1406-07, 160 USPQ 809, 811-812 (CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. . .”).

“A person of ordinary skill is also a person of ordinary creativity, not an automaton.” KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

“Analysis of whether the subject matter of a claim would have been obvious need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court **can take account of the inferences and creative steps that a person of ordinary skill in the art** would employ.” KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir.

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2006); Also, as clarified in KSR, it's now apparent "obvious to try" may be an appropriate test in more situations than previously contemplated. KSR, 127 S. Ct. 1727 at 1742, 82 USPQ2d at 1397 (2007).

When there is motivation: "...to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103." KSR, 127 S. Ct. 1727 at 1742, 82 USPQ2d at 1397 (2007).

"The combination of familiar elements according to known methods is likely to be obvious when it does **no more than yield predictable results.**" KSR Int'l v. Teleflex Inc., 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007).

In this case, since the "previously viewed portion" has been displayed for viewing, i.e., has been for more than a predetermined amount of time it would have been a common sense to implement the displaying of the visual cue based on the "previously displayed portion" to avoid further delay. Such implement have a clear predictable result of displaying the visual cue responsive to next page scrolling. It also clearly predictable that the disadvantage of such implementation is in disjoint scrolling, wherein the visual cue is displayed when it is not needed and not being displayed at all when it is actually needed. Furthermore, as set forth above, having the visual cue is displayed when it is not needed and not being displayed at all when it

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is actually needed is a not preferable to Simonson. It has been held that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In *re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” In *re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

- As for claims 5-6: The visual clues provide visual de-emphasis and visual emphasis of overlapping and non-overlapping information (9:23-10:7).
- As for claim 14: The visual clues provide visual de-emphasis and visual emphasis at a rectangular user focus area bounding a line or several lines (9:35-41).
- As for claim 15: The document can be scrolled in line-by-line increment toward the top or bottom of the window, wherein the Y coordinate of the screen pointer is equal to the Y coordinate of the bottom/top of the effective area (2:42-3:42).
- As for claim 16: The user may define an effective area by using cursor input device (8:15-32).
- As for claims 17, 26: The user may specify the parameter of the visual clues. The parameters include time threshold, display attributes, etc... (8:15-32).

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- As for claim 18: The window is resizable. The visual clues adjusted to the size of the window (11:14-21).
- As for claim 24: The markers are displayed responsive to detected scrolling input event, direction, scrolling increment (see explanation of figures 10-14).
- As for claim 28: The directional visual clues are enabled when the second portion is the last portion of the window related information (9:3-13).

Response to Arguments

REMARKS:

Claim 3 recites “causing visual clues, visually distinguishing new information from old information that overlaps from said first portion and has been displayed in the previous view for *more than a first predetermined amount of time*, to be displayed...”. In response to the argument that the applicant’s invention does not teach any time delays, the argument is acknowledged by the examiner and the term “time delay” will not be further used in the rejection. Instead, the term “have been displayed for a predetermined amount of time” will be used. I.e., the visual cue would not be displayed with the scrolled-in next page unless the first page had been displayed for a predetermined amount of time. This is the delaying the examiner meant to say in previous rejection, i.e., the cost of the pre-determined amount of time. With the modified language above, the examiner hopes that any confusion raised by the term “time delay” has been clarified. Compare to Simonson, the visual clue of Simonson is displayed if the scrolled-in page has been displayed for a predetermined amount of time (“the display state must

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remain unchanged for a certain length of time before any content differentiating indications would be displayed”. Simonson’s 11:28-30).

Simonson teaches *an improvement* such that the displaying of the visual clues is not displayed unless the newly presented portion B is displayed for more than a predetermined amount of time. The improvement helps to avoid persistent background tinting of the previously displayed content which causes user distraction when scrolling quickly through the content. Thus the visual clue will not be displayed if the newly presented portion is not the intended target, such as in disjoint scrolling. In contrast, in the applicant’s invention, the visual clue is displayed regardless whether the newly presented portion is the intended portion or not. This distraction is what Simonson trying to improve.

The differences between Simonson and the claim invention can be demonstrated in the following chart, wherein A, B and C are subsequent pages of a document and DT is display time threshold corresponds to “the page have been displayed for a predetermined amount of time”.

Next-page scrolling	page A	page B	
Claim Invention	DTT	display cue	
Simonson	don’t care	DTT+display cue	
Disjoin scrolling to page C	page A	page B	page C
Claim Invention	DTT	<u>display cue</u>	<u>no cue</u>

Simonson

don't care

no cue

DTT+display cue

It can be seen from the above chart that Simonson's visual cue is displayed at the time the user is needed. As underlined in the above chart, applicant's teaching of displaying the visual cue at page B and no cue at all at page C is what Simonson is trying to overcome (11:22-26, 3:61-4:20). The applicant argues that Simonson's visual clues in disjoint scrolling is disorienting, suggesting the overlap between page A and page C (see the chart above). In response to the argument, Simonson teach providing the visual clue to differentiate the overlapping of the current page with the previous page, not a current page with a viewed (read) page. Thus the user should never be disoriented since he/she already know what the visual clue for.

In response to the applicant's interpretation of the term "delay" used by Simonson as "stopped for a time", the interpretation is not accurate in the context of Simonson. Simonson teaches "persistent tinting of the previously displayed content may be distracting when the user is scrolling quickly through the content. In such a case, the application can include a delay before adding the visual indicator—that is, the display state must remain unchanged for a certain length of time before any content differentiating indications would be displayed" (Simonson's 11:28-30). In this context, the term "delay" imposes a determination to be made, to display or not display the visual clue. In this context, the term "delay" implies do not display the visual indicator to pages that are quickly scrolled through, and display the indicator only to the page has been scrolled-in and displayed for a certain length of time.

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The examiner acknowledges that the applicant's invention does not teach "delay" the displaying of the visual clue, however the applicant teaches that in order for the visual clue to be displayed, the previous page must be displayed for more than a predetermined amount of time. Simonson implements the "predetermined amount of time" in a slight different way: in Simonson, the visual clue is not displayed unless the scrolled-in page has been displayed for a predetermined amount of time. In either method, the visual clue only can be displayed after a predetermined amount, begins from the displaying of the previous page (the claimed invention) or from the displaying of new scrolled-in page (Simonson).

As the term "delay" has been clarified and out of the way as set forth above, the different between the claimed invention and the prior art is that the "predetermined amount of time" is measured at the display of the previous page (applicant's invention) instead of being measured at the scrolled-in new page (Simonson). However, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In *re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969) ("Having established that this knowledge was in the art, the examiner could then properly rely, as put forth by the solicitor, on a **conclusion of obviousness from common knowledge and common sense of the person of ordinary skill in the art** without any specific hint or suggestion in a particular reference."); see also *In re Hoeschele*, 406 F.2d 1403, 1406-07, 160 USPQ 809, 811-812

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(CCPA 1969) (“[I]t is proper to take into account not only specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. . .”).

“**Common sense** teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle...A person of ordinary skill is also a person of ordinary creativity, not an automaton.” KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

“Analysis of whether the subject matter of a claim would have been obvious need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court **can take account of the inferences and creative steps that a person of ordinary skill in the art** would employ.” KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007) quoting In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336-37 (Fed. Cir. 2006); Also, as clarified in KSR, it’s now apparent “obvious to try” may be an appropriate test in more situations than previously contemplated. KSR, 127 S. Ct. 1727 at 1742, 82 USPQ2d at 1397 (2007).

When there is motivation: "...to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103." KSR, 127 S. Ct. 1727 at 1742, 82 USPQ2d at 1397 (2007).

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“The combination of familiar elements according to known methods is likely to be obvious when it does **no more than yield predictable results.**” KSR Int’l v. Teleflex Inc., 127 S.Ct. 1727, 1739, 82 USPQ2d 1385, 1395 (2007).

In this case, since the “previously viewed portion” has been displayed for viewing, it would have been a common sense to implement the displaying of the visual cue based on the “previously displayed portion” to avoid further delay. Such implement have a clear predictable result of displaying the visual cue responsive to next page scrolling. It also clearly predictable that the disadvantage of such implementation is in disjoint scrolling, wherein the visual cue is displayed when it is not needed and not being displayed at all when it is actually needed. Furthermore, as set forth above, having the visual cue is displayed when it is not needed and not being displayed at all when it is actually needed is a not preferable to Simonson. It has been held that A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). “A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

In response to the question whether the examiner agree that no visual clue should be displayed in disjoint scrolling, the examiner do not take the position of an inventor to make judgment that how the product of an invention should be. However there is a different between

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providing a visual clue indicating overlapping portion between a new scrolled-in page and a viewed (read) page, vs. to between a new scrolled-in page and an immediately preceded page. It is depended on how the visual clue is being used. Simonson visual clue can be used to differentiate the content of new scrolled-in page with the precede page.

The applicant alleges that Simonson implement a delay of displaying of the visual clue and alleges that the examiner proposed obvious modification does not make sense, and further request the examiner to rebut the applicant's allegation. First of all, it should be reminded that rebuttal of the examiner rejection lay in the hand of the applicant, not the examiner. However, the examiner would take this opportunity to clarify his reasoning in the obviousness rejection. A prerequisite one must have is the agreement in the meaning of the term "delay" used by Simonson. As set forth above, Simonson teaches "persistent tinting of the previously displayed content may be distracting when the user is scrolling quickly through the content. In such a case, the application can include a delay before adding the visual indicator—that is, the display state must remain unchanged for a certain length of time before any content differentiating indications would be displayed" (Simonson's 11:28-30). In this context, the term "delay" imposes a determination to be made, to display or not display the visual clue. In this context, the term "delay" implies do not display the visual indicator to pages that are quickly scrolled through, and display the indicator only to the page has been scrolled-in and displayed for a certain length of time. Thus if the user quickly scrolls to page B and then to page C, there is no delay happened at page B because the visual clue simply just not displayed. The applicant's invention teaches that in order for the visual clue to be displayed, the

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previous page must be displayed for more than a predetermined amount of time.

Simonson implements the “predetermined amount of time” in a slight different way: the visual clue is not displayed unless the scrolled-in page has been displayed for a predetermined amount of time. The

different between the claimed invention and the prior art is that the “predetermined amount of time” is measured at the display of the previous page (applicant's invention) instead of being measured at the scrolled-in new page (Simonson). The difference would have been obvious to one of skill in the art as set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Huynh whose telephone number is (571) 272-4138. The examiner can normally be reached on Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 571-272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Ba Huynh
/Ba Huynh/
Primary Examiner, Art Unit 2179